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09/816,230	03/26/2001	Koji Nakamura	NEC01P015-ts	5805

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/816,230

Applicant(s)

KOJI NAKAMURA

Examiner

Khanh H. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03/26/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/6/03 and 3/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Detailed Action**

1. This Office Action is responsive to the original Application. Claims 1-45 are pending. Claims 1, 2, 25, 26, 29, 43 and 45 are independent.

***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

4. **Claims 1, 25, 26, 43 and all their dependents are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.**

As an initial matter, the United States Constitution under Art. I, §8, cLesandrini8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited

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times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Thus the present basis for a 35 USC 101 inquiry is a two-prong test :

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As to the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

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invention produces giving a benefit to a user of bulletin boards (i.e., repeatable) to promote contribution by such user to such bulletin boards (i.e., useful and tangible).

However independent claims 1, 25, 26, 43 and all their dependents fail the first prong of the test.

Under this test, for a process claim to pass muster under the “technological arts” prong, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, for example, claim 1 has no connection to the technological arts. The recited steps of merely giving a predetermined benefit... does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of a person, by use of a pencil and paper, then manually and physically presenting to another person.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea which is without connection to the technological arts unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, none of the recited steps, are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 25, 26, 43 and all their dependents are deemed to be directed to non-statutory subject matter.

4. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as

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incorporating a computer network or electronic network or the use of a server into the steps in a non-trivial manner (not just in the preamble). For example in claim 1: “ electronically giving a first client connected to such server system.. contributed to the electronic bulletin board.. ” The other claims could be similarly amended to include a computer network or a server in at least one of the steps.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**6. Claims 2-4, 15, 16, 27, 30, 37-39, and 43-45 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.**

As to claims 2, “contributed .. supplied to a client... from a plurality of clients” is grammatically unsound and confusing. Appropriate correction is required. Claim 2 is interpreted as “storing articles contributed to the bulletin board by a plurality of clients”.

As to claims 3,4,30 (dependent on claims 1, 2, 29 respectively) , there is lack of antecedent basis : is “ reaction” the same as the “level of reaction” in claims 1 or 2? It is interpreted as the same for art purposes. Claims 3 and 4 are also grammatically unsound with “serves” and ‘comprises”, leading to confusion as to the scope of the claims. Appropriate corrections are required.

As to claims 15, 16, 38

“giving said client “ said benefit ... is unclear: It is not clear which clients, the contributing client or the evaluating client is given the benefit. It is interpreted it is the contributing client which is getting the benefit here.

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“from the clients” poses the same issue: which clients?

Further as to claim 38, it seems to be the parallel of claims 15 and 16, in system format. It seems it should be dependent on claims 31 instead of 32 to be consistent with the dependencies of the parallel claims 15 and 16. Appropriate correction is required. It is interpreted herein that claim 38 is dependent on claim 31.

As to claims 27, 39: “assigned to said client” is confusing. It is not clear which clients, the contributing client or the evaluating client is involved here.

Also “contributed... by said client” is confusing. It is suggested to at least identify the clients as first or second clients or as “article-contributing clients” or “evaluating clients”.

Further as to claim 39:

“giving said client”: which client is involved here? It is interpreted as the contributing-contributing client here. Appropriate correction is required.

Claim 37:

“from the same client”: which client is involved here? It is interpreted as the article-contributing client here. Appropriate correction is required.

As to claims 43-45, at many instances, “client” and “said client” are unclear because they could be the contributing client or the evaluating client or both. Appropriate correction is required. It is suggested that at least “first client” and “second client” be used to distinguish.

It is requested of Applicants to review the remainder of the claims and clarify the parties and the grammar as much as possible to avoid 35 U.S.C. 112, second paragraph issues.



***Claim Rejections - 35 USC § 102***

7a. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**7b. Claims 1-6, 15-16, 19-22, 25-26, 29-31, 38, 40-41, and 45 are rejected under 35 U.S.C. 102 (e) as being anticipated by Barney et al, US 6,556,992, herein Barney.**

Barney discloses postings of opinions and other information by some users regarding patents, (which each has its own bulletin board), and wherein the posting users get rated and compensated based on their popularity i.e. based on number of times other users access the opinions/information that they posted (see at least col.29 lines 31 to col.30 lines 9; especially col. 29 lines 63-67). The posting users are also evaluated and compensated based on the quality of their postings i.e. on their veracity/accuracy as viewed by others (see at least col.29 lines 31 to col.30 lines 9; especially col. 29 lines 59-62).

Thus:

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As to claims 1, 2, 25, 26, 29, 45, Barney discloses a system/method using a bulletin board, comprising:  
a plurality of clients;  
an information transmitting server connected to said clients via the Internet, for supplying a bulletin board to said clients and giving a client a predetermined benefit depending on the level of reaction from another client (i.e. the consumer of the posted ratings/ opinions/ other information) with respect to an article which has been contributed to the bulletin board by said client; and  
a customer information managing server for managing information of the clients including said benefit (see at least col.29 lines 59-64; col.30 lines 1-9).

As to claims 3, 4, and 30 (dependent on claims 1, 2, and 29 respectively), BARNEY discloses:  
said reaction from the other client serving as a criterion to give the client said benefit  
comprises an evaluation made by said other client with respect to said article (based on evaluation of veracity/accuracy, see at least col.29 lines 31 to col.30 lines 9; especially col. 29 lines 59-62).

As to claims 5, 6, and 31 (dependent on claims 3, 4 and 29, respectively), BARNEY discloses the benefit is based on the number of answers (i.e. a quantitative value )from clients which have accessed and/or evaluated the article (see above, based on both popularity (number of accesses) and/or accuracy).

As to claims 15, 16 and 38 (dependent on claims 5, 6 and 31 respectively) Barney implicitly discloses:  
evaluating the article by voting for or against the article (voting on the veracity of the article);  
and giving said client said benefit depending on the number of votes for the articles from the clients (based on evaluation of veracity/accuracy, see at least col.29 lines 31 to col. 30 lines 9; especially col. 29 lines 59-62)..

As to claims 19, 20 and 40 (dependent on claims 1, 2, and 29 respectively), BARNEY discloses placing information other than the article contributed by the client on the bulletin board (see at least col. 29 lines 48-51).

As to claims 21, 22 and 41 (dependent on claims 1, 2, and 29 respectively), BARNEY discloses providing a plurality of bulletin boards for respective predetermined categories (see at least col. 29 lines 44-48).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

9. **Claims 7-8, 13-14, 32, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney.**

As to claims 7, 8 and 32 (dependent on claims 3, 4 and 30 respectively), BARNEY does not specifically disclose wherein the evaluation of the articles are made using a multiple values (“multivalued quantitative value”).

However, Barney discloses ranking. Official Notice is taken that it is well-known to rank by using quantitative values according to several factors/attributes. Thus it would have

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been obvious to one skilled in the art at the time the invention was made to use multiple values (“multivalued quantitative value”) for ranking the Barney system because the subject matter (evaluation of patents) may be complex and requires more complex rankings systems as above discussed.

As to claims 13, 14, and 35 (dependent on claims 5, 6, and 32 respectively), Official Notice is taken that compensations are well-known to be calculated over predetermined accounting periods for ease of accounting. Thus it would have been obvious to one skilled in the art at the time the invention was made to set such a predetermined compensation accounting period to Barney’s methods for the above mentioned advantage.

As to claims 36, 37 (dependent on claims 30, 36 ) Barney does not specifically disclose said information transmitting server comprises means for rejecting an evaluation of the same article from the same client which has contributed the article. However Official Notice is taken that it is well-known to reject evaluation from the authors of their own articles. Thus it would have been obvious to one skilled in the art at the time the invention was made to add this feature to the Barney system to ensure integrity of the evaluation system.

**10. Claims 9-12, 17-18, 23-24, 27-28, 33-34, 39, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney as applied to claims 3-4, 30 respectively and further in view of Lesandrini et al, US 2002/0042733, herein Lesandrini.**

Lesandrini discloses community websites, including chat rooms where ads are ranked and opined upon, for rewards points (see at least paragraphs [0009], [0104], [0130], [0224]) and where the community interaction promotes repeat visits and site loyalty (see at least p. 3, paragraphs [0074]).

Thus as to claims 9, 10 and 33 (dependent on claims 3, 4 and 30), Barney does not specifically disclose but LESANDRINI discloses rewarding the evaluating client based on the number of times that said evaluation has been entered (see above) . It would have been obvious

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to one skilled in the art at the time the invention was made to add this teaching of LESANDRINI to Barney to promote the site as taught by Lesandrini.

As to claims 11, 12 (dependent on claims 9 and 10), 34, Official Notice is taken that it is well-known setting a predetermined number of repetitions of any action as a criterion for a reward is well-known such as buying a number of gallons of milk to get a discount on a 7<sup>th</sup> one. The intent is to promote sales/use of the product/service the discount is designed to promote. Thus as Lesandrini discloses rewards for use of the bulletin board, it would have been obvious to one skilled in the art at the time the invention was made to add this common feature of a predetermined number of repetitions of the evaluations of the posted articles, to promote the site as taught by Lesandrini.

As to claims 17, 18 (dependent on claims 1, 2), 27, 28, 39, and 43-44, Barney discloses all the limitations as disclosed above, in particular, evaluation of posted articles and compensation for postings depending on the evaluation by others (i.e. based on their popularity / veracity/accuracy).

Barney does not specifically disclose but LESANDRINI discloses the use of points for compensation (see at least paragraph [0009]). Adding points would have been obvious to be added to Barney as a common accounting means for rewards.

Further, neither Barney nor LESANDRINI specifically discloses displaying such evaluation to the posting party or the points assigned. However Official Notice is taken that it is well-known to communicate any message to anyone by for example email. Thus it would have been obvious to one skilled in the art at the time the invention was made to add to the Barney/LESANDRINI system a notification and display system to the posting authors to apprise them of the evaluations and compensations received from their postings as claimed.

As to claims 23, 24 and 42 (dependent on claims 1, 2, and 29 respectively), BARNEY does not but LESANDRINI does disclose displaying the bulletin board following a page for

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purchasing merchandise (see at least paragraph [0146]). It would have been obvious to one skilled in the art at the time the invention was made to add to Barney the above LESANDRINI's teaching to provide e-commerce opportunities as taught by LESANDRINI (see at least paragraph [0146]).

### **Conclusion**

11. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**"AOL, M/A/R/C, 10 Marketers Test Research via Internet, (America Online and M/A/R/C group will jointly conduct a pilot test of on-line focus groups starting in April 1996)", Dialog File 9 record # 1428621, Brandweek, v XXXVII, n10, p. 9, March 04, 1996,** discloses opinion rewards where consumers are rewarded for participating in chat sessions to offer opinions on products and related topics.

**"Starmedia Network Rewards Online Users with Puntos", PR Newswire, Thursday, Aug. 31, 2000", Dialog File 613, Record # 00405547, herein Starmedia,** discloses consumers earning points for participating in a variety of online experiences e.g. visiting websites, replying to bulletin postings, participating in selected chat rooms, bulletin boards.

Chen et al., US 6741969 B1, discloses system and method for reducing excess capacity for restaurants including chat rooms (see at least Fig. 5, item 550, and associated text), point rewards for participating in certain activities, personal rewards page.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov). ( However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

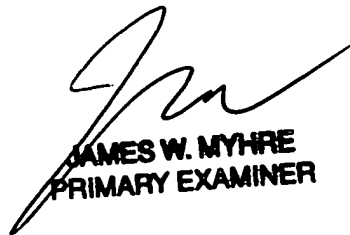
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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

September 17, 2004

KHL



**JAMES W. MYHRE**  
**PRIMARY EXAMINER**